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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	T	ATTORNEY-DOCKET NO.
097100,533	06/19/98	HUTCHENS		

HM12/0823

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WESSENER EXAMINER

ART UNIT

PAPER NUMBER

08/23/98

DATE MAILED:

Please find below and/or attached an Office communication concerning this application r  
proceeding.

Commissioner of Patents and Trademarks

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**Office Action Summary**

Application No.  
**09/100,633**

Applicant(s)  
**Hutchens et al**

Examiner  
**T. Wessendorf**

Group Art Unit  
**1618**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-35 are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

x FAX TRANSMISSION

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, drawn to a method of identifying a ligand, classified in class 435, subclass 7.1.
  - II. Claims 2-24 and 27, drawn to method of detecting genetic package and translation of polynucleotide and a substrate classified in classes 435, 436 and 536, subclasses 5, 532 and 23.1, respectively.
  - III. Claims 28-29, drawn to a method classified in class 436, subclass 532.
  - IV. Claims 25-26 and 30-35 drawn to a substrate comprising a polypeptide adsorbent and a screening method for determining whether an agent modulates binding, classified in classes 435 and 536, subclasses 5 and 23.1, respectively.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different methods of detecting, identifying or screening different ligands or modulating agents. For example, the method recited in Group I can be used to identify ligands such as hormone, enzymes, polypeptides, contaminants etc. binding to their corresponding receptors and can be accomplished by other bacterial means or chemical means as by chromatography as evidenced by Hutchens (WO 94 28418) and not necessarily by the phage display library recited in the method of Group II. Likewise, the method of Group I is distinct from the method of Group III. The method of Group III appears to be drawn to the reusing of an analyte-adsorbent in subsequent sample analysis. Group IV screening method for an agent is drawn to a different function and operations requiring more process steps than the method of Group I which merely requires detection of binding between a ligand to its receptor.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. A telephone call was made to J. Storella on 8/3/99 to request an oral election to the above restriction-requirement, but did not result in an election being made.
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Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Wessendorf whose telephone number is (703) 3967. The examiner can normally be reached on Mon. to Fri. from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, Ph.D., can be reached on (703) 308-0570. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Tdw

8/16/99

*T. Wessendorf*  
*Patent Examiner*